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EXAMINER

STIBLEY, MICHAEL R

ART UNIT	PAPER NUMBER
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3688

NOTIFICATION DATE	DELIVERY MODE
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02/20/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/814,814	Applicant(s) COTTEN ET AL.	
	Examiner MICHAEL R. STIBLEY	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26, 28-45 is/are pending in the application.
- 4a) Of the above claim(s) 1-25 and 41-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26 and 28-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/01/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the claim amendments and remarks filed on 11/12/2008. Please note change in Examiner.

Response to Arguments

2. Applicant's remarks of 11/12/2008 are based on the newly amended claims and such arguments are fully addressed in the present Office Action as featured below.

Election/Restriction Requirement

3. Claims 1-25, 26, 28-45 are currently pending in the instant application and have been examined. Claims 1-25 have been withdrawn and Examiner requests that Applicant Cancel these claims. Applicant elected Group IV without traverse on 4/30/2008 in response to a Restriction Requirement of 4/01/2008. The Restriction Requirement of 4/01/2008 is hereby made FINAL. Claims 41-45 were newly added by Applicant on 11/12/2008 and Examiner is withdrawing them from consideration, as an election by Original Presentation.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- X. Claims 26, 28-40, drawn to customer satisfaction of one or more predetermined criteria associated with a promotional event, said predetermined criteria comprising achieving a particular result in a promotional contest
- XI. Claims 41-45, drawn to deactivating said purchase card upon passage of a predetermined duration of time from said activating.

The inventions are distinct, each from the other because of the following reasons:

Inventions X and XI are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because **Group X is drawn to customer satisfaction of one or more predetermined criteria associated with a promotional event, said predetermined criteria comprising achieving a particular result in a promotional contest**

. The subcombination has separate utility such as **Group XI is drawn to deactivating said purchase card upon passage of a predetermined duration of time from said activating.**

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

ELECTION BY ORIGINAL PRESENTATION

4. Newly submitted claims 41-45 directed to an invention that is independent or distinct from the invention originally claimed for the reasons outlined above.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 41-45, Group XI is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 26 and 28-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

As per Claims 26 and 28-40: Claims 26 and 28-40 are rejected under 35 U.S.C. 101 as drawn to a non-statutory subject matter. The claims (or at least independent claims 26, uncured by the dependent claims) are related to manual processes, which is not patentable. Indeed, the claims (e.g. claims 26) recite a process, which is not tied to a particular machine nor transform the underlying subject matter (such as an article or materials) to a different state or thing. See MPEP §2106.IV.B: *Determine Whether the Claimed Invention Falls Within An Enumerated Statutory Category*. See also the following U.S. Supreme Court cases: *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); and *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876). The claims are not tied to a particular machine.

Examiner suggests that Applicant incorporates computer architecture (hardware) into the body of the claims in a non-nominal (i.e. not insignificant extra-solution activity) way so that the

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claim positively recites the particular machine to which it is tied, e.g., by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, e.g., the material being changed to a different state.

Examiner further notes that the Diehr Court stated that “insignificant post-solution activity will not transform an unpatentable principle into a patentable process. 450 U.S. at 191-192.

Examiner further notes that The Court in Flook, 437 U.S. at 590 stated “The notion that post-solution activity, no matter how conventional or obvious in itself, can transform an unpatentable principle into a patentable process exalts form over substance.” Flook further outlines that the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. Further, the inherent step of gathering data can also fairly be characterized as insignificant extra-solution activity See Flook, 437 U.S. at 590.

Examiner further notes the publication of In re Bilski, 88 USPQ2d 1385.

Examiner notes that Applicant may show that a process claim satisfies §101 either by showing that Applicant's claim is tied to a particular machine, or by showing that Applicant's claim transforms an article. See Benson, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by Benson, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See Benson, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See Flook, 437 U.S. at 590.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 26-40 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to Claim 26-40, although the acronym URL may be known to represent Uniform Resource Locator at the present time, its meaning within the art may change over time. Thus, it must be linked to the plain text meaning at least once in the parent claim or in the claim itself (for each claim set).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 26, 28 and 30-40 are rejected under 35 U.S.C. 103(a) as being obvious in view of Toader et al. (US Patent No. 5,749,075) (“Toader”) and of Kazaks et al. (US Patent Application Publication No. 2002/0046341) (“Kazaks”).**

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Regarding claim 26, Toader discloses: A method of incentivizing future purchases by customers, said method comprising:

- a) providing an inactivated purchase card to a customer, after the customer satisfies one or more predetermined criteria associated with a promotional event, said predetermined criteria comprising achieving a particular result in a promotional contest wherein said purchase card displays a an identification number for the customer to visit; (col 5, lns 4-30; col 1 lines 35-40)
- b) receiving a call from the customer; (col 5, lns 18-20)
- c) receiving from the customer during the call a card identification number associated with said purchase card; (col 5, lns 20-27)
- d) providing to the customer during said visit one or more survey questions; (fig 1, elm 11; col 4, lns 5-19)
- e) receiving from the customer during said visit responses to said survey questions; and (fig. 1, elm 5; col 5, ln 67 to col 6, ln 8)
- f) activating said purchase card with a predetermined value in response to receiving one or more responses from the customer to said survey questions. (col 6, lns 4-7)

Toader does not specifically disclose a web site to be visited for registering the card or for shopping. However, Kazaks discloses web sites to register purchasing cards, to shop and to provide/receive further information ([0021], [0041], [0046]). Thus, it would have been obvious for one of ordinary skill in the art at the time of the invention to combine Toader's teachings with Kazaks' in order to create more customer convenience and a better service.

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Regarding claim 28, Toader discloses: The method of Claim 26, wherein said purchase card is provided to the customer manually. (standard marketing techniques in col 2, lns 63-66; col 5, lns 34-38)

Regarding claim 30, Toader discloses: The method of Claim 26, wherein said activating comprises providing the customer with a personal identification number associated with said purchase card. (col 5, lns 8-11)

Regarding claim 31, Toader discloses: The method of Claim 26, wherein said activating comprises applying a balance (time balance equates credit balance as time buys telephone conversations) to said purchase card. (col 6, lns 40-51; col 7, lns 25-30; col 9, lns 42-43)

Regarding claim 32, Toader discloses: The method of Claim 30, further comprising disabling the access capability of the purchase card after a predetermined amount of time. (col 3, lns 48-58; col 4, lns 5-8; col 5, lns 30-34)

Regarding claim 33, Toader discloses: The method of Claim 31, further comprising setting to zero the balance (time balance equates credit balance as time buys telephone conversations) associated with said purchase card after a predetermined amount of time. (col 3, lns 25-30, lns 48-58; col 4, lns 20-24; col 5, lns 46-50; col 6, lns 31-36)

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Regarding claim 34, Toader discloses: The method of Claim 26. Toader does not specifically disclose further comprising providing the customer with instructions to visit said web site to activate said purchase card (col 5, lns 4-30). However, it is old and well known that besides phone lines, one can use web sites to register purchasing cards (see Kazacks [0021], [0041], [0046]). Thus, it would have been obvious for one of ordinary skill in the art at the time of the invention to use also a web site to register a purchasing card. This creates more customer convenience.

Regarding claim 35, Toader discloses: The method of Claim 26, wherein said survey questions are provided to the customer. (fig 1, elm 11; col 3, lns 33-35; col 4, lns 5-19)

Regarding claim 36, Toader discloses: The method of Claim 26, wherein said responses are received from the customer via user interfaces. (fig. 1, elm 5; col 3, lns 33-37; col 5, ln 67 to col 6, ln 8)

Regarding claim 37, Toader discloses: The method of Claim 26, wherein said activated purchase card enables the customer to make purchases at one or more retail locations limited to a predetermined set of authorized retail locations. (Col 1 lines 65-67)

Regarding claim 38, Toader discloses: The method of Claim 26, wherein said activated purchase card enables the customer to purchase one or more products limited to a predetermined set of authorized products. (Col 3 lines 60-67)

Regarding claim 39, Toader discloses: The method of Claim 26, wherein said predetermined value changes automatically over time. (Col 7 lines 45-50)

Regarding claim 40, Toader discloses: The method of Claim 39, wherein said predetermined value has a first value on weekdays and a second value on weekends. (Col 3 lines 24-26)

11. Claim 29 is rejected under 35 U.S.C. 103(a) as being obvious in view of Toader et al. (US Patent No. 5,749,075) (“Toader”), and of Kazaks et al. (US Patent Application Publication No. 2002/0046341) (“Kazaks”) as applied to claim 1 above, and in further view of Frazee (US Patent No. 6,829,596) (“Frazee”).

Regarding claim 29, Toader and Kazaks disclose: The method of Claim 26. The references do not specifically disclose wherein said purchase card is provided to the customer automatically. However, Frazee discloses automatically dispensing purchasing cards by means of vending machines (col 2, ln 42 to col 3, ln 9). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Toader's and Kazaks' teaching with Frazee's in order to increase the number of card distribution methods, thus increasing sales numbers and volumes.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. STIBLEY whose telephone number is (571) 270-3612. The examiner can normally be reached on Monday-Friday 9 a.m.-5 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES W. MYHRE can be reached on (571) 272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MICHAEL R. STIBLEY/
Examiner, Art Unit 3688
Tuesday, February 17, 2009

/Jean Janvier/

Primary Examiner, Art Unit 3688